



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,824	03/22/2001	Bert Vogelstein	01107.00112	8421

22907 7590 09/18/2002

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

CHAKRABARTI, ARUN K

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 09/18/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,824

Applicant(s)

VOGELSTEIN ET AL.

Examiner

Arun Chakrabarti

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 22-38, 40 and 41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-21, 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

Art Unit: 1634

DETAILED ACTION

Election/Restriction

1. Applicant's election of Group I, corresponding to claims 14-21, and 42 in Paper No. 9 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse. (MPEP § 818.03(a)).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-21 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A final process step is lacking in claim 14 which would conclusively provide a physiological effect of wild-type p53 protein to a cell. It is suggested that this claim be rewritten to clarify the method steps being performed. Method claims should be made clear by providing a last step or phrase in the last step that states the accomplishment of the goals for the method which were stated in the method's preamble. Claim 14 lacks such a last step and is confusing because the additional method step is not sufficiently set forth. While minute details are not

Art Unit: 1634

required in method claims, at least the basic steps must be recited in a positive, active fashion. See Ex parte Erlich, 3 USPQ2d1011, p.1011 (Bd. Pat. App. Int. 1986). Specifically, while the preamble of claim 14 recites a method of providing the physiological effect of wild-type p53 protein to a cell, the final method step simply provides to a cell a compound which is able to complex specifically with a p53-specific binding site with no correlation to the preamble method of providing the physiological effect of wild-type p53 protein to a cell.

Claim 17 is rejected over the recitation of the phrase, "part of human wild-type p53 protein". It is not clear if a single amino acid of human wild-type p53 protein is claimed or not. The metes and bounds of the claim is vague and indefinite.

Claim 19 is rejected over the recitation of the phrase, "a portion of the monomer sequence". It is not clear if a single nucleotide of the monomer is claimed or not. The metes and bounds of the claim is vague and indefinite.

Claim 19 is also rejected over the recitation of the phrase, "sequences adjacent to the monomer sequence in the human genome". In absence of any lower and upper limit of the sequences, it is not clear if a single nucleotide adjacent to the monomer sequence of the human genome is claimed or all the nucleotides of the whole human genome is claimed. The metes and bounds of the claim is vague and indefinite.

Claim 20 is rejected in absence of the upper limit of the monomer sequences in the oligonucleotide. It is not clear if infinite number of monomer sequences are claimed. The metes and bounds of the claim is vague and indefinite.

Art Unit: 1634

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

5. Claims 14-15, 18-21 and 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 5,955,263. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-22 of U.S. Patent No. 5,955,263 disclose the method of

Art Unit: 1634

providing to a tissue (inherently containing cells) a compound comprising at least a portion of the monomer sequence RRRCWWGY and comprising at least two of the monomer sequence TGCCT. It is obvious to an ordinary practitioner that physiological effect of wild-type p53 protein to a cell is provided in the claims 1-22 of U.S. Patent No. 5,955,263.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group analyst Chantae Dessau whose telephone number is (703) 605-1237.

Arun Chakrabarti,

Patent Examiner,

September 4, 2002


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600